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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,151	07/27/2001	Martin E. Kordesch	XDEV1100	5628

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EXAMINER

CHU, CHRIS C

ART UNIT	PAPER NUMBER
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2815

DATE MAILED: 07/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,151

Applicant(s)

KORDESCH ET AL.

Examiner

Chris C. Chu

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 15 is/are pending in the application.
- 4a) Of the above claim(s) 1 - 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 - 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 4.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II in Paper No. 6 is acknowledged. The traversal is on the ground(s) that "[I]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (M.P.E.P. § 803). ... Due to the co-extensive searching, searching and examination of the entire application must be made in accordance with the M.P.E.P. Therefore, Applicants respectfully request withdrawal of the restriction requirement for not meeting the search burden requirement set forth in the M.P.E.P." This is not found persuasive because the method claims of the instant invention, especially, claim 2 recites the following sentence, "wherein the third compound semiconductor material is formed by sputtering." This requires a search in specific subclasses of Class 438, which is the method class. However, the apparatus claims have no such limitation, which requires no such search. Therefore, examiner does not agree with the basis of the applicant's argument that "[I]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." However, if applicant states for the record that the apparatus claims and method claims are not patentably distinct, then the restriction requirement will be withdrawn.

The requirement is still deemed proper and is therefore made FINAL.

Further, applicant argues “[T]he Office action uses an ‘independent OR distinct’ standard when the language in 35 U.S.C. § 121 clearly requires ‘independent AND distinct’ (emphasis added).” The argument is not persuasive. The previous Office action clearly wrote that Groups I and II are independent **AND** distinct inventions, specifically, paragraph one explains the independent invention between Group I and II and paragraph two explains the distinction between the Group I and II.

Even further, applicant argues “claim 1 is linked to claim 9.” The argument is not persuasive because claim 1 is not the necessary process of making for the claim 9. For example, the product as claimed in claim 9 can be made by a materially different process such as forming a third compound semiconductor material on the first compound semiconductor layer; patterning the third compound semiconductor material; depositing an insulating material on the patterned third compound semiconductor material; removing the insulating material except a portion adjacent the third compound semiconductor material; forming a second semiconductor layer between the patterned third compound semiconductor material. Therefore, claim 1 is not linked to claim 9.

Oath/Declaration

2. A new oath or declaration is required because the photocopied pages of the declaration do not show the inventor’s signatures. The wording of an oath or declaration cannot be amended.

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If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: on page 7, line 4 of the specification refers to a silicon carbide “60” which is not referenced in the figures. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation in claim 14 “surfaces of the insulating layer and metal contacts furthest from the substrate lie in substantially a same plane” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 14 and 15, the terms "substantially" and "approximately" are relative terms which render the claims indefinite. The terms "substantially" and "approximately" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 9 ~ 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Baliga.

Regarding claim 9, Baliga discloses in Fig. 3 and column 6, lines 18 ~ 21 a

semiconductor device comprising:

- a first active layer (13) including a first compound semiconductor material and having a first conductive type;
- a second active layer (17) including a second compound semiconductor material and having a second conductivity type opposite the first conductivity type, wherein the second active layer contacts the first active layer;
- a third active layer (19) including a third compound semiconductor material and having the first conductive type, wherein:
 - o the third active layer contacts the second active layer; and
 - o a combination of the first, second, and third active layers are at least part of a transistor (10);
- an opening (the place of 24, 25 and 26) extending through the third active layer and contacting the second active layer;

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- a fourth compound semiconductor material (26) at least partially within the opening,
 - o wherein the fourth compound semiconductor material:
 - o has the second conductivity type and a dopant concentration higher than a dopant concentration of the second active layer; and is electrically connected to the second active layer; and an insulating layer (24) at least partially within the opening, wherein the insulating layer lies between the third active layer and the fourth compound semiconductor material.

Regarding claim 10, since Baliga does not limit each of the first, second, third and fourth compound semiconductor material to any particular or specific material, hence his/her disclosure encompasses all well known compound semiconductor material including "at least two Group IVA elements."

Regarding claim 11, since Baliga does not limit each of the first, second, third and fourth compound semiconductor material to any particular or specific material, hence his/her disclosure encompasses all well known compound semiconductor material including "silicon carbide."

Regarding claim 12, Baliga discloses in Fig. 3 electrical contacts (20) to the third active layer and the fourth compound semiconductor material.

Regarding claim 13, Baliga discloses in Fig. 3 and column 7, lines 13 ~ 16 the electrical contacts being ohmic.

Regarding claim 14, Baliga discloses in Fig. 3 surfaces of the insulating layer and metal contacts furthest from the substrate lie in substantially a same plane.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baliga in view of Driver et al.

Baliga discloses the claimed invention except for the second active layer having a thickness in a range of approximately 0.1 – 2 microns thick. However, Driver et al. discloses in column 4, lines 24 ~ 34 an active layer having a thickness in a range of approximately 0.1 – 2 microns thick. Thus, it would have been obvious to one of ordinary skill in the art at the time when the invention was made to modify Baliga by using the thickness in a range of approximately 0.1 – 2 microns thick for the second active layer as taught by Driver et al. The ordinary artisan would have been motivated to modify Baliga in the manner described above for at least the purpose of decreasing doping concentration (column 4, lines 28 ~ 34).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Park, Harris et al., Okazawa and Tamaki et al. disclose a transistor.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris C. Chu whose telephone number is (703) 305-6194. The examiner can normally be reached on M-F (10:30 - 7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie C. Lee can be reached on (703) 308-1690. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7382 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Chris C. Chu
Examiner
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c.c.
June 26, 2002

A handwritten signature in black ink, appearing to read 'E. Lee', with a large, sweeping initial 'E'.

EDDIE LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800